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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,680	02/06/2004	Stanislav Bliakhman	CA920030048US1	7538

7590

09/29/2006

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EXAMINER
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SHAH, AMEE A

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 09/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/773,680	<b>Applicant(s)</b> BLIAKHMAN ET AL.	
	<b>Examiner</b> Amea A. Shah	<b>Art Unit</b> 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2004.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date: _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/6/04</u> .  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

Claims 1-20 are pending in this action.

#### ***Drawings***

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) and (5) because:

(1) reference character “207” has been used to designate both a step of selection order object and a step of updating selection order object (flow diagram of Fig. 2 and Specification, pages 8-9);

(2) reference character “203” has been used to designate both a step of quoting parent order object (flow diagram of Fig. 2 and Spec., pages 8-9) and an item of a quotation parent order object (Fig. 3 and Specification, pages 9-10);

(3) reference character “212” has been used to designate both an order tracking process and an inventory report process (Specification, page 9);

(4) reference character “260” has been used to designate both a general attribute section (Fig. 11 and Specification, page 18) and an inventory report (Fig. 12 and Specification, page 18);

(5) reference character “270” has been used to designate both a list of ordered assets (Fig. 11 and Specification, page 18) and a table showing the history of inventory adjustments (Fig. 12 and Specification, page 18);

(6) they do not include the following reference sign(s) mentioned in the description: 280 and 290 (Specification, page 18); and

(7) they include the following reference character(s) not mentioned in the description:  
602 (Fig. 6), 1002, 1008 and 1009 (Fig. 10).

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 U.S.C. § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-13 and 20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-13 are directed to a "commerce site." The Specification describes the commerce site as a Website. Websites are defined as "a group of HTML documents and associated files, scripts, and databases that is served up by an HTTP server on the World Wide Web." (*See Microsoft Press Computer Dictionary, 3<sup>rd</sup> ed.*, Microsoft Corp., Redmond, WA, 1997, page 506.) Therefore, web sites are essentially compilations of

Art Unit: 3625

data without sufficient structure to be patented as a process, machine, manufacture or composition of matter, or improvement thereon, i.e. claims 1-13 are directed to disembodied data structure claims which are per se not statutory. *C.f. In re Wamerdam.*

Data structures not claims as embodied in computer-readable media are descriptive material *per se* and are not statutory because they are not capable of causing functions change in the computer. *See, e.g., Wamerdam.* Such claimed structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized, and are descriptions or expressions of a program and not a physical "thing," i.e. they are neither computer components nor statutory processes. Thus, they are non-statutory under §101. The Examiner suggests redrafting the claims to include sufficient structure as servers, processors and databases to be statutory under 35 U.S.C. §101. For purposes of this action only, the Examiner will examine the claims as if sufficient structure is defined (i.e. servers, processors, communication lines, and databases).

Similarly, claim 20 is directed to a communications signal having modulated thereon computer readable executable instructions. Since signals are merely energy, they are nonstatutory natural phenomena. *See O'Reilly v. Morse*, 56 U.S. (15 How.) 62 at 112-14 (1853). Moreover, a signal encoded with functional descriptive material does not fall within any of the categories of patentable subject matter set forth in §101. It is not a process, because it is not a series of steps. The other three classes of §101, i.e. machine, and compositions of matter and manufactures, have traditionally required physical structure or material. Thus, a claim directed

Art Unit: 3625

to a signal is directed to non-statutory subject matter under §101. Claim 20 will not be examined in this action.

***Examiner Note***

Examiner cites particular pages, columns, paragraphs and/or line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

***Claim Rejections - 35 U.S.C. § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1, 2, 11, 14 and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Wharton, US 2005/0027611 A1 (hereafter referred to as “Wharton”).**

Referring to claim 1. Wharton discloses a commerce site for exchanging commerce information with a plurality of remote store sites and shopper clients over a computer network (*e.g.* Fig. 1), the commerce site comprising:

- a marketplace store for exchanging information with shopper clients and remote store sites through the computer network (§0026 – note the marketplace is the electronic mall); and
- a plurality of proxy stores, each proxy store associated with one of the remote store sites for communicating therewith over the computer network and acting as an intermediary for information exchanged between the associated remote store site and the marketplace store (§§0026-27 – note the proxies are the e-commerce portals through which vendors are coupled).

Referring to claim 2. Wharton also discloses the commerce site of claim 1 further comprising:

- a catalog identifying an aggregation of assets offered through a plurality of remote store sites connected to the computer network (§§0027 and 0037 and claim 1);
- wherein the marketplace store has access to the catalog for creating a parent list identifying assets selected from the catalog by one of the shopper clients over the network (§0030 – note the parent list is the global shopping basket); and
- each proxy store is configured for reading the parent list and creating a first request identifying at least some of the assets in the parent list and sending the first request over the computer network to the remote store site associated therewith (§§0032-33 – note that each vendor commerce system is programmed to communicate transaction information).

Art Unit: 3625

Referring to claim 11. Wharton further discloses the commerce site of claim 2 wherein the marketplace catalog, marketplace store and the proxy stores are all resident on a common computer coupled to the computer network (§0026).

Referring to claims 14 and 19. All of the limitations in method and apparatus claims 14 and 19 are closely parallel to the limitations of apparatus claims 1 and 2, analyzed above and are rejected on the same bases.

***Claim Rejections - 35 U.S.C. § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).



**Claims 3-10, 12 and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wharton in view of King et al., US 2002/0152133 A1 (hereafter referred to as “King”).**

Referring to claim 3. Wharton discloses the commerce site of claim 2, as discussed above, wherein transaction packets transfer information from vendor commerce systems to the marketplace (¶0032). The transaction packets may contain a variety of information (¶0032). However, Wharton does not explicitly disclose wherein each proxy store is configured for receiving an associated initial quote response from its associated remote store site in reply to the first request, the initial quote response identifying at least some of the assets identified in the first request and associated prices, and creating an associated initial quote list identifying the assets and associated prices identified in the initial quote response, the commerce site including an interface for presenting to the shopper client the initial quote lists associated with a plurality of the proxy stores.

King, in the same field of endeavor of a electronic shopping, discloses an on-line marketplace that enables negotiation between a buyer and seller wherein buyers are able to check the price and/or availability of goods with one or more sellers, including wherein sellers are configured to:

- receiving an associated initial quote response from its associated remote store site in reply to the first request, the initial quote response identifying at least some of the assets identified in the first request and associated prices (¶¶0080-82 – note that the quote response is the “Req Check Response”), and

Art Unit: 3625

- creating an associated initial quote list identifying the assets and associated prices identified in the initial quote response, the commerce site including an interface for presenting to the shopper client the initial quote lists associated with a plurality of the proxy stores (§0083).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the site of Wharton to include the teachings of King to allow for each proxy store to be configured for receiving an associated initial quote response from its associated remote store site in reply to the first request (i.e. the transaction packets to include quote responses), the initial quote response identifying at least some of the assets identified in the first request and associated prices, and creating an associated initial quote list identifying the assets and associated prices identified in the initial quote response, the commerce site including an interface for presenting to the shopper client the initial quote lists associated with a plurality of the proxy stores. Doing so would allow for a buyer to inquire into the price and availability of goods in order to make a more informed buying decision, and therefore increase customer satisfaction, as suggested by King (§0004 and 0008).

Referring to claim 4. Wharton in view of King discloses the commerce site of claim 3 wherein an associated initial quote response can identify substitute assets and associated prices in place of at least some of the assets identified in the first request (King, §0082), each proxy store being configured to identify in the initial quote list associated therewith any substitute assets and associated prices identified in the initial quote response received by the proxy store (King, §0082), the commerce site interface permitting a client shopper to select assets and substitute assets from the presented initial quote lists, (King, §0082 and 0085 – note the substitute assets

Art Unit: 3625

are in the counter-proposal) and each proxy store being further configured for (c) creating an associated selection list identifying the assets and substitute assets selected by the client shopper from the initial quote list associated with the proxy store (King, ¶¶0082-0083), and (d) sending the associated selection list over the computer network to the computer remote store associated therewith (King, ¶0084) in order to provide a more real-life shopping experience by allowing the customer to see and possible choose substitutions for products not in stock, thereby increasing the possibility of sales and of customer satisfaction.

Referring to claim 5. Wharton in view of King discloses the commerce site of claim 4 wherein the marketplace store is configured to assign a unique identifier to each asset listed in the parent list, each proxy store being configured to assign a correlation ID to each asset and substitute asset listed in the initial quote and selection lists thereby correlating the assets listed therein to assets listed in the parent list (Wharton, ¶0032-33 – note the unique identifier can be the SKU number or product identification).

Referring to claim 6. Wharton in view of King discloses the commerce site of claim 3, wherein the parent list includes, for each identified asset, a desired quantity of the asset as selected by the shopper client (Wharton, ¶0033), the proxy stores including the desired quantities in the first requests associated therewith (Wharton, ¶0033), the initial quote responses each identifying an available quantity of the assets identified therein (King, ¶0082), the available quantity being included in the presented initial quote lists (King, ¶0082), the commerce site interface permitting a client shopper to select assets from the presented initial quote lists and

Art Unit: 3625

specify an updated desired quantity of the selected assets (King, ¶¶0084-85), each proxy store being further configured for (c) creating an associated selection list identifying the assets selected by the client shopper from the initial quote list associated with the proxy store and the specified updated desired quantity thereof (King, ¶¶0082-0083), and (d) sending the associated selection list over network to the remote store associated therewith (King ¶0084) in order to provide a more real-life shopping experience by allowing the customer to see and possible choose substitutions for products not in stock, thereby increasing the possibility of sales and of customer satisfaction.

Referring to claim 7. Wharton in view of King discloses the commerce site of claim 6 wherein the initial quote responses include a projected availability date for the assets identified therein and a quantity of the asset available on the availability date (King, ¶¶0080-0082) in order for customers to make a more informed decision as to whether their requirements are met, including delivery requirements, thereby better replicating a more realistic negotiation between customers and suppliers, as suggested by King (¶0004).

Referring to claim 8. Wharton in view of King discloses the commerce site of claim 3 the commerce site interface permitting a client shopper to select assets from the presented initial quote lists (King, ¶0084), each proxy store being further configured for (c) creating an associated selection list identifying the assets selected by the client shopper from the initial quote list associated with the proxy store (King, ¶¶0084-85), and (d) sending the associated selection list

Art Unit: 3625

over network to the remote store associated therewith (Wharton, ¶0033 and King, ¶0095) in order to create an order for the products and consummate the sale.

Referring to claim 9. Wharton in view of King discloses the commerce site of claim 8 each proxy store further configured for (e) receiving an associated further quote response from its associated remote store site in reply to the selection list, the further quote response identifying the assets identified in the selection list and associated prices (King, ¶0085), and (f) creating an associated further quote list identifying the assets and associated prices identified in the further quote response (King, ¶0085); the commerce site interface configured for presenting to the shopper client the further quote lists (King, ¶0085 – note the lists are in the confirm email) in order for customers to make a more informed decision as to whether their requirements are met, including delivery requirements, thereby better replicating a more realistic negotiation between customers and suppliers, as suggested by King (¶0004).

Referring to claim 10. Wharton in view of King discloses the commerce site of claim 9 the commerce site interface permitting a client shopper to select assets from the presented further quote lists (King, ¶0107), each proxy store being further configured for (g) updating the associated selection list associated therewith to identify the assets selected by the client shopper from the further quote list associated with the proxy store (King, ¶01017), and (h) sending the updated selection list over network to the remote store associated therewith (King, ¶0107-09) in order for customers to better order what they desire and to better replicate a more realistic negotiation between customers and suppliers, as suggested by King (¶0004).

Referring to claim 12. Wharton further discloses the commerce site of claim 2 wherein each proxy store is configured to receive status information from the remote store associated therewith about orders for assets submitted to the remote store associated therewith, the commerce site including an interface for presenting the status information to a requesting shopper client (King, ¶0086) in order for customers obtain shipping information if needed, leading to higher customer satisfaction.

Referring to claims 15-17. All of the limitations in method claims 15-17 are closely parallel to the limitations of apparatus claim 3, 4 and 12, analyzed above and are rejected on the same bases.

**Claims 13 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wharton in view of Palmer et al., US 2002/0107763 A1 (hereafter referred to as “Palmer”).**

Referring to claim 13. Wharton discloses the commerce site of claim 1, as discussed supra, but does not disclose wherein each proxy store is configured for receiving and storing inventory information received from the remote store associated therewith. Palmer, in the same field of endeavor of electronic shopping, discloses a system and process for determining availability of products including a presentation layer, a configurator, a data access layer and availability manager, wherein the availability manager is configured for receiving and storing inventory information received from the remote store associated therewith (¶¶0047-48).

Art Unit: 3625

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the site of Wharton to include the teachings of Palmer to allow for each proxy store is configured for receiving and storing inventory information received from the remote store associated therewith. Doing so would allow for customers to obtain accurate availability information in an efficient manner, as suggested by Palmer (¶0007), thereby increasing the likelihood of sales and customer satisfaction.

Referring to claim 18. All of the limitations in method claim 18 are closely parallel to the limitations of apparatus claim 13, analyzed above and are rejected on the same bases.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(1) Lyons et al., US 2002/0077937 A1, discloses an apparatus and method for ensuring availability of inventory for electronic commerce including receiving product identifications and determining availability of products at desired retail locations (*see, e.g.*, pages 2-7).

(2) Zustak et al, US 2002/0088001 A1, discloses a quote and information system using a proxy to obtain quotes from vendors (*see, e.g.*, pages 5-8).

(3) Bansal et al., US 2002/0198814 A1, discloses a system, method and program for conducting on-line negotiations and matching between buyers and sellers, including using proxies (intermediaries) to conduct negotiations, determine availability and prices, and facilitate sale (*see, e.g.*, pages 4-8).

Art Unit: 3625

(4) Fortes et al., US 2003/0036991 A1, discloses a method and apparatus for enhancing communication between suppliers and buyers including generating requests for quotes, inquiring from suppliers as to availability and prices on items requested, and providing buyer with results (*see, e.g.*, pages 2-5).

(5) Nowers et al., US 2003/0033205 A1, discloses a method and system for facilitating fulfillment of electronic transactions through at least one electronic storefront establishing inventory at a single physical location, such inventory comprising products received from a plurality of vendors (*see, e.g.*, pages 1-16).

(6) Vishik et al., US 2003/0204448 A1, discloses a system and method for creating an electronic marketplace involving metacatalogs (*see, e.g.*, 2-12).

(7) Baughman, US 6,816,843 B1, discloses a method and apparatus for conducting purchases in private over a network including using proxies to conduct transactions (*see, e.g.*, columns 2-7).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amee A. Shah whose telephone number is 571-272-8116. The examiner can normally be reached on Mon.-Fri. 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

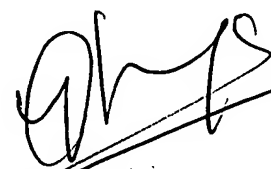


Art Unit: 3625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AAS

September 26, 2006



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